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10/521,898	01/14/2005	Olivier J. Poncelet	84231JJH	7126
7590 Eastman Kodak Company Patent Legal Staff 343 State Street Rochester, NY 14650-2201				
EXAMINER JOY, DAVID J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**DETAILED ACTION**

1. Claims 1-3 and 5-25 are pending as amended on September 22, 2008, with Claim 4 having been cancelled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment***

3. Applicant's amended abstract, filed September 22, 2008, with respect to conforming the abstract to the proper language and format thereof, has been fully considered and is corrective. Therefore, the previously cited objection to the abstract of the disclosure is withdrawn.
4. Applicant's amendments to Claims 1 and 2, and the corresponding cancellation of Claim 4, in the amendment filed on September 22, 2008 obviates the previously cited rejections under 35 U.S.C. §112. The rejection of Claims 1-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, has been withdrawn.

Likewise, the rejection of Claims 1-25 under 35 U.S.C. §112, second paragraph, as being indefinite, has been withdrawn.

5. Applicant's cancellation of Claim 4, in the amendment filed September 22, 2008, renders the previously cited rejection under 35 U.S.C. §103 moot. Therefore, the rejection of Claim 4 under 35 U.S.C. §103(a) as being unpatentable over the U.S. Patent of Liu et al. (6,548,149; hereinafter "Liu") in view of the U.S. Patent of Poncelet et al. (5,916,946; hereinafter "Poncelet") has been withdrawn.

***Terminal Disclaimer***

6. The terminal disclaimer filed on September 22, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent Application Nos. 10/521,899, 10/563,693, 10/578,813 and 11/573,148 has been reviewed and is NOT accepted. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The application/patent being disclaimed has been improperly identified since the numbers used to identify the pending patent applications being disclaimed are incorrect. The correct numbers appear hereinabove.

***Claim Rejections - 35 USC § 103***

7. Claims 1-3 and 5-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Poncelet.
  
8. Liu teaches an ink jet recording element comprising a support and an ink jet receiving layer, and the ink jet receiving layer contains a polyvinyl alcohol binder and an aluminosilicate polymer (see Abstract; see also Column 5, Lines 38-53; see also Column 6, Lines 55-63; see also Column 7, Lines 13-26; see also Column 10, Lines 45-55). Liu also teaches that the aluminosilicate used in the ink jet receiving layer has an Al/Si molar ratio of 1:4 to 4:1 (see Column 9, Lines 44-61), and that the use of the aluminosilicate results in the ink jet receiving layer having an enhanced gloss, an enhanced weathering resistance, and that the layer produces images having enhanced quality. In addition, Liu recites that the ink receiving layer, after printing, contains an amount of aluminosilicate particles that is from 50 to 100% by weight of the ink receiving layer and the additional ink-absorbent layer, which clearly meets the broad recitation of an amount between 5 and 95%, as in the present claim (see Column 15, Lines 42-57). In combining the aluminosilicate polymer with the suitable binder, it follows that Liu also provides that a coating composition for the ink-receiving layer is thus obtained. Liu's teachings, however, merely recite a general teaching that

aluminosilicate can be used in the ink jet receiving layer to achieve these results.

Poncelet, drawn to an organic/inorganic composite and photographic product containing such a composite, teaches a hybrid, organic/inorganic composite aluminosilicate polymer having an Al/Si molar ratio between 1 and 3, and an Al concentration between  $5 \times 10^{-4}$  and  $5 \times 10^{-2}$  mol/l (see Column 1, Lines 6-10; see also Column 2, Line 55 – Column 3, Line 9; see also Claim 1). Poncelet also teaches that the organic/inorganic composite aluminosilicate polymer can be used in image-receiving layers and products having these layers applied thereon, and that such layers exhibit enhanced performance characteristics (see Column 1, Lines 6-10; see also Column 3, Lines 50-65; see also Column 4, Lines 6-21). As both Liu and Poncelet are drawn to analogous fields of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to have made the ink jet recording material taught by Liu and to incorporate the composite polymer taught by Poncelet.

9. Claims 1-3 and 5-22 are viewed as product-by-process claims and hence the methods that the aluminosilicate is created by are not pertinent, unless applicant can show a different product is produced, despite that fact that Liu recites that the inclusion of the aluminosilicate in the ink-receiving layer results in an ink jet recording material that has a high gloss, produces high quality printed images and has a good dye keeping

time. Likewise, Poncelet recites that the use of the hybrid, organic/inorganic polymer can be used in image-receiving layers and products having these layers applied thereon, and that such layers exhibit enhanced performance characteristics. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

11. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

12. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-3 and 5-22 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3, 5-8, and 10-22 of copending Application No. 10/521,899. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter

dealing with the hybrid aluminosilicate polymer's production that is claimed in the instant application is fully disclosed in the copending application and would be covered by any patent granted on that copending application since the claims found in both the copending application and the instant application are claiming common subject matter, as follows: a polymer obtainable by a method for preparing a hybrid aluminosilicate polymer comprising steps for treating a mixed aluminum and silicon alkoxide comprising both hydrolyzable substituents and a non-hydrolyzable substituent with an aqueous alkali, in the presence of silanol, stirring the mixture in the presence of silanol groups until a polymer is formed, and eliminating the byproducts from the reaction medium. Since the scope of the instant claims and the scope of the claims in the copending application are overlapping, the claimed subject matter of the instant claims is not patentably distinct over the claims of the copending application.

14. Claims 1, 2, 5-7, 9-16 and 24 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 8-18 of copending Application No. 10/563,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter dealing with the hybrid aluminosilicate polymer's production that is claimed in the instant application is fully disclosed in the copending application and would be covered



by any patent granted on that copending application since the claims found in both the copending application and the instant application are claiming common subject matter, as follows: a polymer obtainable by a method for preparing a hybrid aluminosilicate polymer comprising steps for treating a mixed aluminum and silicon alkoxide comprising both hydrolyzable substituents and a non-hydrolyzable substituent with an aqueous alkali, in the presence of silanol, stirring the mixture in the presence of silanol groups until a polymer is formed, and eliminating the byproducts from the reaction medium. Since the scope of the instant claims and the scope of the claims in the copending application are overlapping, the claimed subject matter of the instant claims is not patentably distinct over the claims of the copending application. The copending application also claims the addition of inorganic particles in the ink-receiving layer. However, the claims of the instant application also leave open the possibility that such particles could be added to the ink-receiving layer of the present invention, as it is claimed using open-ended "comprising" language.

15. Claims 1, 2, 5-16, 23 and 24 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-17 of copending Application No. 10/578,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter

dealing with the hybrid aluminosilicate polymer's production that is claimed in the instant application is fully disclosed in the copending application and would be covered by any patent granted on that copending application since the claims found in both the copending application and the instant application are claiming common subject matter, as follows: a polymer obtainable by a method for preparing a hybrid aluminosilicate polymer comprising steps for treating a mixed aluminum and silicon alkoxide comprising both hydrolyzable substituents and a non-hydrolyzable substituent with an aqueous alkali, in the presence of silanol, stirring the mixture in the presence of silanol groups until a polymer is formed, and eliminating the byproducts from the reaction medium. Since the scope of the instant claims and the scope of the claims in the copending application are overlapping, the claimed subject matter of the instant claims is not patentably distinct over the claims of the copending application. The copending application also claims that the support, upon which the ink-receiving layer is positioned, has additional layers other than the ink-receiving layer. However, the claims of the instant application also leave open the possibility that a multilayered support could be used, as the claims describe the presence of a support and the layer that is applied thereon, but they are claimed using open-ended "comprising" language.

16. Claims 1, 2 and 6-16 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 6-9 and 12-18 of copending Application No. 11/573,148. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter dealing with the hybrid aluminosilicate polymer's production that is claimed in the instant application is fully disclosed in the copending application and would be covered by any patent granted on that copending application since the claims found in both the copending application and the instant application are claiming common subject matter, as follows: a polymer obtainable by a method for preparing a hybrid aluminosilicate polymer comprising steps for treating a mixed aluminum and silicon alkoxide comprising both hydrolyzable substituents and a non-hydrolyzable substituent with an aqueous alkali, in the presence of silanol, stirring the mixture in the presence of silanol groups until a polymer is formed, and eliminating the byproducts from the reaction medium. Since the scope of the instant claims and the scope of the claims in the copending application are overlapping, the claimed subject matter of the instant claims is not patentably distinct over the claims of the copending application. While the copending application initially claims that the aluminum and silicon compounds have only hydrolyzable substituents, the dependent claims that depend upon the initial, independent claim, recite that the aluminosilicate can be a hybrid such that it is made

up of aluminum compounds and silicon compounds having both hydrolyzable and non-hydrolyzable substituents.

17. These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

18. As for the citations to the teachings contained in the specifications of the copending applications cited to hereinabove, Applicant's attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent (underlining added by examiner for emphasis). *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970). Consistent with the above underlined portion of the MPEP citation, the aforementioned references to the specifications of the instant applications are proper.

***Response to Arguments***

19. Applicant's arguments filed September 22, 2008 have been fully considered but they are not persuasive.

20. Applicant argues that Liu does not disclose, teach or suggest an aluminosilicate polymer obtained by the preparation method claimed. However, it is noted that Applicant's assertions are insufficient as they must show objective evidence of the claimed process, the process taught in the reference, and a clear showing of how the claimed process renders the final product that is obtained different and patentably distinct from that which is obtained in the reference. While Applicant points to Comparative Example 1 and Comparative Example 5 in the present specification, the data is not persuasive given that it does not compare the present invention with the Liu reference. There is no evidence that the product produced by the process of Liu is different than that which is presently claimed.

21. Although Liu does not disclose that the aluminosilicate polymer is obtained by the preparation method that is presently claimed, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP §2113. Therefore, absent clear evidence of criticality regarding the presently claimed process and given that Liu meets the requirements of the claimed ink jet recording element, Liu clearly meet the requirements of Claims 1-3 and 5-22.

22. Applicant also argues that the method by which the hybrid aluminosilicate polymer taught in Poncelet is prepared by a method that contains many distinct elements from the claimed invention. However, while it is agreed that Poncelet does not disclose all the features of the present claimed invention, Poncelet is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 U.S.P.Q. 224, 226 (C.C.P.A. 1973); *In re Keller* 624 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Rather, this reference teaches a certain concept (i.e., the inclusion of a

specific aluminosilicate polymer into a photographic element), and in combination with the primary reference discloses the presently-claimed invention.

23. In addition, Applicant argues that the cited references comprise non-analogous art. Applicant is reminded that according to MPEP 2141.01(a), a reference may be relied on as a basis for rejection of an applicant's invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Poncelet is, therefore, a reasonably pertinent reference, because it teaches the inclusion of a hybrid aluminosilicate polymer into a photographic element, which is a function/feature that is especially pertinent to the invention at hand and Liu et al.

24. Further, Applicant states that a terminal disclaimer was filed to overcome the double patenting rejections. The status of the terminal disclaimer and the rejections of the claims on the grounds of nonstatutory obviousness-type double patenting have been addressed hereinabove.

***Conclusion***

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.



28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/  
Examiner, Art Unit 1794  
12/31/2008

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794